

### REMARKS/ARGUMENTS

Applicants respectfully request further examination and reconsideration in view of the instant response. Claims 11, 12, 14, 16, 25, and 27-36 remain pending in the case. Claims 11, 12, 14, 16, and 25 are rejected. Claims 13, 17-21, 23-24 and 26 are canceled herein. Claims 11-14, 16 and 25 are amended herein. No new matter has been added as a result of the amendments. Support for the amendments can be found in the instant specification at least at paragraphs 10, 24-27, and 40.

### DECISION ON APPEAL

Applicants note that the Decision on Appeal recites that “[t]he Appellants have overcome the prima facie showing of anticipation as to the rejection of claims 11, 13, 14, 16, and 25-36. We enter a new ground of rejection under 35 U.S.C. § 103(a) on claims 11 and 25. We enter a new ground of rejection under 35 U.S.C. §101 on claims 11-14 and 16.” (Decision on Appeal; page 14). Applicants note that the rejection of Claims 26-36 was reversed and no new grounds of rejection were added for Claims 26-36. Accordingly, Applicants address herein the sustained rejections for Claims 12 as well as the new grounds of rejection for 11, 12, 14, 16 and 25.

### ALLOWABLE SUBJECT MATTER

Applicants note that the rejection of Claims 26-36 was reversed and no new grounds of rejection were added for Claims 26-36. Therefore, Applicants respectfully submit that Claims 26-36 are allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

35 U.S.C. §101

The Decision on Appeal introduces a New Ground of Rejection and states that Claims 11-14 and 16 are rejected under 35 U.S.C. §101. In particular, it is asserted in the Decision on Appeal that Claims 11-14 and 16 are directed toward non-statutory subject matter. Claim 13 has been canceled herein; therefore a discussion of Claim 13 is moot. Specifically, the Decision on Appeal states that Claim 11 “encompasses forms of the executable instructions being embodied on a transitory propagating signal per se” and that a “signal does not fit within at least one of the four statutory subject matter categories” (Decision on Appeal; page 19). Applicant respectfully submits that Claims 11, 12, 14 and 16 are directed to patentable subject matter for at least the following rationale.

Applicants respectfully note that Claim 11 has been amended to recite, emphasis added, a “computer readable storage medium containing executable instructions that when executed by a computer system implement a method.” As such, Applicants submit that Claim 11 does not encompass forms of the executable instructions being embodied on a transitory propagating signal and is therefore directed to statutory subject matter. Claims 12, 14 and 16 have been similarly amended. Therefore Applicants respectfully submit that Claims 11, 12, 14 and 16 overcome the rejection under 35 U.S.C. §101.

35 U.S.C. §102(b)

The Decision on Appeal sustained the rejection under 35 U.S.C. §102(b) of Claims 23 and 24 as being anticipated by U.S. Patent Application Publication No. 2002/0099643 to Abeshouse et al., hereinafter referred to as Abeshouse. Claims 23 and 24 have been canceled herein; therefore a discussion of Claims 23 and 24 is moot.

35 U.S.C. §103(a)

The Decision on Appeal sustained the rejection under 35 U.S.C. §103(a) of Claims 12 and 17-21 as being unpatenable over Abeshouse in view of U.S. Patent Application Publication No. 2005/0055299 to Chambers et al., hereinafter referred to as Chambers. The Decision on Appeal entered a new ground of rejection under 35 U.S.C. §103(a) of Claims 11 and 25 as being unpatentable over Abeshouse in view of Chambers. Claims 17-21 have been canceled herein; therefore a discussion of Claims 17-21 is moot. Applicants submit that Claims 11, 12 and 25 are patentable over Abeshouse in view of Chambers for at least the following rationale.

“As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries” including “[a]scertaining the differences between the claimed invention and the prior art” (MPEP 2141(II)). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention

as a whole would have been obvious” (emphasis in original; MPEP 2141.02(I)).

Applicants note that “[t]he prior art reference (or references when combined) need not teach or suggest all the claim limitations, however, Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art” (emphasis added; MPEP 2141(III)).

Applicants respectfully note that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention” (emphasis in original; MPEP 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

#### Claims 11 and 12

Applicants respectfully submit that as a whole, Abeshouse and Chambers, alone or in combination, fail to suggest all of the features of Applicants’ Claim 11.

Applicants respectfully point out that independent Claim 11, as amended, recites (emphasis added):

A computer readable storage medium containing executable instructions that when executed by a computer system implement a method comprising:  
allowing selection of a feedback rule for an online auction contemporaneously with an end-user initiating the online auction; and  
allowing the end user to change selection of feedback rules for the online auction during the online auction.

Claim 12 depends from independent Claim 11. Therefore, by demonstrating that Claim 11 is patentable over the combination of Abeshouse and Chambers it is also demonstrated that Claim 12 is patentable over the combination of Abeshouse and Chambers.

Applicants respectfully submit that Abeshouse does not teach, describe or suggest “allowing the end user to change selection of feedback rules for the online auction during the online auction” as recited in independent Claim 11.

Applicants understand Abeshouse to disclose, “‘Differential market feedback technology’ includes a variety of feedback mechanisms that may be used to differentiate bidders 30 while ‘differential market feedback rules’ are used to define when a bidder 30 can view market feedback and may use differential market feedback technology in that determination” (Abeshouse, paragraph 80).

Applicants respectfully submit that “‘Differential market feedback technology’ includes a variety of feedback mechanisms,” as disclosed by Abeshouse, does not teach, describe or suggest “allowing the end user to change selection of feedback rules for the online auction during the online auction” as disclosed by Applicants’ Claim 11.

The Decision on Appeal states that Abeshouse does not disclose all features of Applicants Claim 11 (Decision on Appeal; page 18). Chambers is relied on to overcome

this shortcoming. Applicants have reviewed Chambers and understand Chambers to disclose,

“The rules also notify the carriers regarding the scope of information disclosure during the bidding process. For example, will carriers see all the questions and answers regardless of who submitted the question or will they only be able to view their own questions and answers; will carriers be able to see just the bid amount from other carriers or all the bid data such as deviations and the resulting cost deltas, and will competing carriers be openly identified or merely aliased during the reporting of an auction.”

(emphasis added; Chambers, paragraph 80). Applicants respectfully submit that the “rules also notify the carriers regarding the scope of information disclosure during the bidding process,” as disclosed by Chambers, does not teach, describe or suggest “allowing the end user to change selection of feedback rules for the online auction during the online auction,” as disclosed by Applicants’ Claim 11, and therefore does not overcome the shortcomings of Abeshouse.

Applicants respectfully assert that the combination of Abeshouse and Chambers does not teach, disclose or suggest the claimed embodiments as recited in independent Claim 11 that this claim overcomes the rejection under 35 U.S.C. § 103(a), and this claim is thus in a condition for allowance. Therefore, Applicants respectfully submit that the combination of Abeshouse and Chambers also do not teach or suggest the additional claimed embodiments as recited in Claim 12, that this claim also overcomes the rejection under 35 U.S.C. § 103(a), and are is a condition for allowance as being dependent on an allowable base claim.

#### Claim 25

Applicants respectfully submit that as a whole, Abeshouse and Chambers, alone or in combination, fail to suggest all of the features of Applicants' Claim 25.

Applicants respectfully point out that independent Claim 25, as amended, recites (emphasis added):

A system for controlling an auction, comprising:  
interface means for providing a user interface through which an end-user may input details for an auction, including feedback rules regarding information provided to bidders about status of the auction wherein the interface means allows the end-user to dynamically customize feedback provided to the bidders during the auction; and  
auction means for carrying out the auction over a network in accordance with the input details for the auction.

Applicants respectfully submit that Abeshouse does not teach, describe or suggest "the interface means allows the end-user to dynamically customize feedback provided to the bidders during the auction" as recited in independent Claim 25.

Applicants understand Abeshouse to disclose, "Differential market feedback technology' includes a variety of feedback mechanisms that may be used to differentiate bidders 30 while 'differential market feedback rules' are used to define when a bidder 30 can view market feedback and may use differential market feedback technology in that determination" (Abeshouse, paragraph 80).

Applicants respectfully submit that "Differential market feedback technology' includes a variety of feedback mechanisms," as disclosed by Abeshouse, does not

teach, describe or suggest “the interface means allows the end-user to dynamically customize feedback provided to the bidders during the auction” as disclosed by Applicants’ Claim 25.

The Decision on Appeal states that Abeshouse does not disclose all features of Applicants Claim 25 (Decision on Appeal; page 18). Chambers is relied on to overcome this shortcoming. Applicants have reviewed Chambers and understand Chambers to disclose,

“The rules also notify the carriers regarding the scope of information disclosure during the bidding process. For example, will carriers see all the questions and answers regardless of who submitted the question or will they only be able to view their own questions and answers; will carriers be able to see just the bid amount from other carriers or all the bid data such as deviations and the resulting cost deltas, and will competing carriers be openly identified or merely aliased during the reporting of an auction.”

(emphasis added; Chambers, paragraph 80). Applicants respectfully submit that the “rules also notify the carriers regarding the scope of information disclosure during the bidding process,” as disclosed by Chambers, does not teach, describe or suggest “the interface means allows the end-user to dynamically customize feedback provided to the bidders during the auction,” as disclosed by Applicants’ Claim 25, and therefore does not overcome the shortcomings of Abeshouse.

Applicants respectfully assert that the combination of Abeshouse and Chambers does not teach, disclose or suggest the claimed embodiments as recited in independent Claim 25 that this claim overcomes the rejection under 35 U.S.C. § 103(a), and that this claim is thus in a condition for allowance.



CONCLUSION

In light of the above remarks, Applicants respectfully request reconsideration of the rejected Claims.

Based on the arguments presented above, the Applicants respectfully assert that Claims 11, 12, 14, 16, and 25 overcome the rejections of record and, therefore, the Applicants respectfully solicit allowance of these Claims. Also Applicants respectfully submit that Claims 27-36 are allowable.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

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